

1 REMARKS

2 Status of the Claims

3 Claims 1 - 8 and 10 - 33 remain pending in the present application. Applicants have amended
4 Claims 1, 18, and 24 to make clear a distinction that applicants believed to be apparent in the claims prior
5 to this amendment, but which it appears may not have been evident to the Examiner.

6 Summary of Telephone Interview

7 Applicants' attorney conducted a telephone interview with Examiner Paula on March 9, 2006.
8 During the interview, applicants' attorney first directed Examiner Paula's attention to Claim 1, paragraph
9 (b), which recites "using a special application programming interface (API) module accessed from within
10 the application program, for interfacing the application program with a TWAIN module." Applicants'
11 attorney then requested Examiner Paula to point out the specific portion of the TWAIN reference teaching
12 that recitation in applicants' Claim. Examiner Paula referred to the portion of the TWAIN reference
13 relied on in the previous office action, which describes that the Logitech SAPI was used "as a basis for the
14 TWAIN standard," and applicants' attorney reiterated that this portion of the TWAIN reference actually
15 does not teach using a separate and distinct Special API module accessed within an application that is
16 used for interfacing with the TWAIN module. Examiner Paula then agreed that the TWAIN reference
17 does not explicitly teach a separate and distinct SAPI in addition to a TWAIN module, but that applicants'
18 recitation did not explicitly recite that the SAPI was a separate and distinct module and not part of the
19 TWAIN module. It was then agreed that applicants' attorney should submit a response to the outstanding
20 Office Action that amends the claims to more clearly recite that the SAPI is separate and distinct from the
21 TWAIN module.

22 Examiner Paula indicated that the suggested amendment alone may be insufficient to overcome
23 the cited art, but agreed to reconsider the amended claims and perform a new search based on applicants'
24 amendment and response. Therefore, this response includes amendments to each of the independent
25 claims to make clearer this distinction over the cited art. In Claim 24, the amendment indicates that the
26 SAPI is separate and distinct from the "source manager module." (The source manager module is a
27 portion of TWAIN, as noted in the cited TWAIN reference.)

28 Applicants' attorney would like to thank Examiner Paula for his willingness to discuss the prior
29 art in connection with Claim 1 (and correspondingly, in regard to the other independent claims). While
30 no decision regarding the patentability of the claims was reached during the interview, it is clear that the

1 prosecution was advanced by the discussion, and it is hoped that any further issues that may remain can
2 readily be resolved during another telephone discussion.

3 Claims Rejected Under USC § 103(a)

4 The Examiner has rejected independent Claims 1, 3, 15-16, 24-25, 27-28, and 29-31 under
5 35 USC § 103(a) as being obvious in view of Corel WordPerfect 6.1, 1996, in view of "Twain White
6 Paper," (<http://www.twain.org>) 1996, pages 1-4, (herein referred to as "the TWAIN reference"). Claims
7 2, 6, 10, 12, and 17 were rejected under 35 USC § 103(a) as being obvious over Corel WordPerfect 6.1,
8 1996 in view of the TWAIN reference, and further in view of "Ulead PhotoImpact 3.0" User Guide for
9 Windows 95 and Windows NT 3.51, 1996, pp. 104-107, 111-114, and 162-167 (hereinafter,
10 "Photoimpact"). Claims 4-5, 18, 21-23, and 32-33 were rejected under 35 USC § 103(a) as being obvious
11 over Corel WordPerfect 6.1, 1996, in view of the TWAIN reference, and further in view of U.S. Patent
12 No. 5,907,665 to Sobol et al. (hereinafter, "Sobol"). Claims 7-8, 11, 13, 14, 19, 20, 26, and 31 were
13 rejected under 35 USC § 103(a) as being obvious over Corel WordPerfect 6.1, 1996 (hereinafter,
14 "WordPerfect"), in view of the TWAIN reference, and further in view of one or more of the following:
15 "Mastering Photoshop 5 for the Web," 1998, pp. 1-10, "Troubleshooting and configuring the Windows
16 NT/95 Registry," Clayton Johnson, 1997, pp. 1-2, TWAIN specification version 1.8, 10/22/98, U.S.
17 Patent No. 5,845,076 to Arakawa, the Sobol patent, and U.S. Patent No. 6,154,756 to Hearn. Applicants
18 respectfully disagree that the references disclose all of the steps or elements of the recitation in these
19 claims for at least the reasons set forth below.

20 In the interest of reducing the complexity of the issues for the Examiner to consider in this
21 response, the following discussion focuses on independent Claims 1, 18, and 24 (as amended). The
22 patentability of each remaining dependent claim is not necessarily separately addressed in detail.
23 However, applicants' decision not to discuss the differences between the cited art and each dependent
24 claim should not be considered as an admission that applicants concur with the Examiner's conclusion
25 that these dependent claims are not patentable over the disclosure in the cited references. Similarly,
26 applicants' decision not to discuss differences between the prior art and every claim element, or every
27 comment made by the Examiner, should not be considered as an admission that applicants concur with
28 the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe that all of
29 the dependent claims are patentable over the cited references. Moreover, a specific traverse of the
30

1 rejection of each dependent claim is not required, since dependent claims are patentable for at least the
2 same reasons as the independent claims from which the dependent claims ultimately depend.

3 Applicants have amended Claim 1 to recite "the special API module being *entirely separate and*
4 *distinct from the TWAIN module*" (emphasis added). The cited reference states that the TWAIN
5 specification was based in part on a Logitech SAPI, but does NOT teach or suggest using a special
6 application programming interface that is *entirely separate and distinct from the TWAIN module* and
7 which is used to provide "a user interface that is presented to a user within and under control of the
8 application program." There is no teaching in regard to the function of the Logitech SAPI, and nothing to
9 suggest that it performed the specific purpose of the SAPI recited by applicants' claims.

10 On page 3, under the heading "Architecture," the TWAIN reference teaches that TWAIN is to be
11 employed to connect "TWAIN-compliant applications with TWAIN-aware devices." This section of the
12 reference further teaches a Source Manager is one of the components of TWAIN and that "[T]he
13 application communicates through the Source Manager to Source driver which represents the physical
14 hardware device that generates image data." Accordingly, as taught by this reference, in the prior art, the
15 Source Manager of TWAIN directly communicates with an application. Paragraph (b) of applicants'
16 Claim 1 clearly provides that a separate and distinct SAPI is provided to isolate "a user from directly
17 interacting with the TWAIN module and thereby simplifying the step of acquiring the image." Paragraph
18 (c) of Claim 1 states that "the special API module [is employed] for negotiating with the image source
19 device that is active to determine a set of image capture parameters that control said image source device
20 when acquiring the image." Therefore, the recitation of applicants' claims regarding the SAPI module is
21 directed to a novel and non-obvious step/element, since it is neither disclosed nor suggested by the cited
22 art.

23 Claims 18 has been similarly amended and is therefore allowable over the cited art for at least the
24 same reasons presented for the allowability of Claim 1. Claim 24 has been amended to recite that the
25 SAPI is "entirely separate and distinct from the source manager module." As described above, the cited
26 reference does not teach or suggest a SAPI that carries out such a function and therefore, Claim 24 is also
27 allowable over the cited art generally for at least the same reasons as stated for Claims 1 and 18.

28 Furthermore, none of the cited art mentions a special API module having any functionality like
29 that recited in applicants' Claims 1, 18, and 24 (as amended). There is no disclosure or suggestion of how
30 the *functionality* provided by this module can be achieved in either the WordPerfect or TWAIN

1 references or a combination thereof. Clearly, the functions achieved by applicants' recited special API
2 module are not carried out by any element or component taught or suggested by the WordPerfect or
3 TWAIN references, and the Examiner must show such a teaching in the art to support his position that it
4 would be obvious to combine the WordPerfect and TWAIN references to provide an equivalent of each
5 step or element recited in applicants' claims. Accordingly, it is clear that such a combination could not be
6 achieved by simply combining the cited references, since there is no enabling disclosure in any of these
7 references that would lead one of ordinary skill in the art to modify WordPerfect or TWAIN to provide
8 such an SAPI or arrive at such functionality for the SAPI.

9 Applicants' recognition of the problems inherent with the TWAIN standard are discussed at length
10 in applicants' specification to illustrate why applicants developed the approach and system as defined by
11 their claims, as further clarification of why that approach is novel and non-obvious over the prior art. For
12 example, at page 39, line 12 through page 40, line 15, applicants distinguish the use of a SAPI for
13 interfacing with a TWAIN module from the use of a TWAIN module alone, as follows:

14 The MSOTW9.DLL API module allows an application program to implement various
15 features of TWAIN by providing an API that comprises a single entry point. In this way, it is not
16 necessary for the application program to call any of the TWAIN calls available through the
17 TWAIN.DLL API. The MSOTW9.DLL module also handles the necessary changes to the
18 application's event loop, as discussed above, without requiring the event loop within the application to
19 be altered. Furthermore, the MSOTW9.DLL API module provides functionality that is not directly
20 available from the TWAIN.DLL API module, such as generating drop-down menu structures
21 comprising a list of available image acquisition devices and verifying whether an image acquisition
22 device can actually support automatic scanning.

23 In order to implement the features of the invention in accord with one preferred embodiment,
24 it is necessary to install the MSOTW9.DLL API module, the TWAIN.DLL API module, and
25 appropriate device driver files and/or libraries on a computer. Both the WINDOWS 98™ and
26 WINDOWS NT™ operating systems can be installed with all the necessary TWAIN modules during
27 their initial installation, or during a subsequent update. In addition to the TWAIN.DLL module, it
28 may be necessary to install a TWAIN_32.DLL module, along with TWUNK_16.EXE and
29 TWUNK_32.EXE files. The TWUNK files allow a programs and/or drivers written for a 16-bit
30 environment to operate in a 32-bit environment.

One of the objectives of the MSOTW9.DLL API module is to allow an application to
automatically scan an image and insert the image into a document with minimal user input. Typically,
in order to perform a scan under the prior art, it is necessary to invoke the TWAIN Source Manager
select source dialog to select a device, and then to invoke a TWAIN compliant user interface for the

1 selected image acquisition device that is provided by the manufacturer of the device, through the
2 driver.ds file. This user interface commonly comprises one or more dialogs that contain various
3 parameters that must be set in order to obtain an image. Although the use of such an interface allows
4 specific capabilities and parameters to be set, it is often the case that a set of default parameters can be
5 used to obtain acceptable results, in a much simpler fashion.

6 In order to scan an image under the present invention, it is also necessary to select an
7 available image acquisition device (even if only confirming a default image acquisition device). The
8 MSOTW9.DLL API allows an application program user to select an available data acquisition device
9 without having to use the normal TWAIN Source Manager Select Source dialog. The
10 MSOTW9.DLL API provides a dialog (upon selection of an "Acquire Image" menu item in the
11 application) that includes a drop-down list box, which is used for selecting an active image acquisition
12 device from among a list of devices that is automatically generated by the API.

13 In addition to the above cited portion of applicants' specification, pages 7-38 of the specification
14 describe the TWAIN standard in exceptional detail, and starting on page 42, applicants provide a
15 thorough explanation entitled "Bypassing the Source User Interface," which further distinguishes
16 applicants functionality from the prior art. Throughout applicants' specification, considerable explanation
17 of the TWAIN standard is provided at a logical level in order to demonstrate applicants' full
18 understanding of the TWAIN specification and consequent recognition of its limitations, which led to
19 applicants' novel and non-obvious approach for addressing these limitations as recited in applicants'
20 claims.

21 Based upon the comments made above, it should be evident that all claims in the present
22 application are patentable. Accordingly, the application should be passed to issue without further delay.
23 If any issues remain, the Examiner is invited to telephone applicants' attorney at the number listed below.

24 Respectfully submitted,

25 

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28 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed
29 envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, Alexandria,
30 VA 22313-1450, on April 05, 2006.

Date: April 05, 2006

